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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,624	08/28/2003	Hiroki Yamauchi	2003_1212A	5300
513 7590 02/06/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER CERVETTI, DAVID GARCIA	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/649,624

**Applicant(s)**

YAMAUCHI ET AL.

**Examiner**

David García Cervetti

**Art Unit**

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's arguments filed November 13, 2007, have been fully considered.
2. Claims 29-44 are pending and have been examined. Claims 1-28 have been cancelled.

### ***Response to Amendment***

3. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.
4. Regarding the refusal by Applicant to provide a n English translation, Examiner respectfully submits that under CFR 37 1.55 (a) (4) (i) (C), an English language translation of a non-English language foreign application is not required except when specifically required by the examiner.

### ***Double Patenting***

5. Claims 29-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of US Patent 7,188,224. Although the conflicting claims are not identical, they are not patentably distinct from each other because
  - a content management apparatus operable to manage a number of content duplications performed on a plurality of apparatuses connected to a network, comprising:
  - a holding unit operable to respectively hold an in-group remaining number and an out-group remaining number, the in-group remaining number indicating a number of permitted content duplications performed

- on an apparatus belonging to a predetermined group, and the out-group remaining number indicating a number of permitted duplications performed on an apparatus not belonging to the predetermined group;
- a group judging unit operable to judge whether at least one apparatus of the plurality of apparatuses belongs to the predetermined group; and
  - a management unit operable to manage the number of content duplications performed on the at least one apparatus based on the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications performed on the at least one apparatus based on the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit (**claim 29, instant application**) is analogous to a networked apparatus that belongs to a group, and that is connected via a network to at least one device in the group and to at least one device out of the group, said networked apparatus comprising:
    - a storage unit operable to store a content and duplication restricting information that is attached to the content, the duplication restricting information indicating a permitted number of duplications, which represents a number of times that the content is able to be duplicated to a device, wherein the permitted number of duplications is a sum of a

permitted number of duplications to a first type of device and a permitted number of duplications to a second type of device;

- a receiving unit operable to receive, from a device, a duplication request for the content;
- a judging unit operable to judge whether the device is in the group or out of the group; and
- a control unit operable to duplicate the content to the device if said judging unit judges that the device is in the group, and impose restrictions on duplication of the content to the device if said judging unit judges that the device is out of the group (**claim 1, patent**);

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims of the **instant application** have **not** in fact **been patented**.

7. Claims 1-20 of US Patent 7,188,224 contain every element of claims 29-44 of the instant application and thus anticipate the claims of the instant application. Claims 29-44 of the instant application therefore are not patently distinct from the US Patent claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

8. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re

Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

9. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. *In re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (*In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993).

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**11. Claims 29-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Alve et al. (US Patent Application Publication 2003/0076955, hereinafter Alve).**

**Regarding claims 29 and 41-43, Alve teaches**

a content management apparatus operable to manage a number of content duplications performed on a plurality of apparatuses connected to a network, comprising  
**(abstract):**

a holding unit operable to respectively hold an in-group remaining number and an out-group remaining number, the in-group remaining number indicating a number of permitted content duplications performed on an apparatus belonging to a predetermined group, and the out-group remaining number indicating a number of permitted duplications performed on an apparatus not belonging to the predetermined group  
**(pars. 43-52, copy control, domain traversal);**

a group judging unit operable to judge whether at least one apparatus of the plurality of apparatuses belongs to the predetermined group **(pars. 43-52, domain traversal);** and

a management unit operable to manage the number of content duplications performed on the at least one apparatus based on the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications performed on the at least one apparatus based on the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit  
**(pars. 60-65, copy control, domain traversal, positive integer).**

**Regarding claim 30**, Alve teaches an acquisition unit operable to acquire a duplication request from the at least one apparatus, wherein said group judging unit is operable to judge whether the at least one apparatus which has made the duplication request belongs to the predetermined group, and said management unit is operable to accept the duplication request and subtract "1" from the in-group remaining number if the in-group remaining number is not "0" and reject the duplication request if the in-group remaining number is "0" when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and accept the duplication request and subtract "1" from the out-group remaining number if the out-group remaining number is not "0" and reject the duplication request if the out-group remaining number is "0" when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit **(pars. 43-52, copy control, domain traversal, 56-59, verifying device belongs to domain, 60-65, copy control, domain traversal, positive integer)**.

**Regarding claim 31**, Alve teaches an acquisition unit operable to acquire a deletion request from the at least one apparatus, wherein said group judging unit is operable to judge whether the at least one apparatus which made the deletion request belongs to the predetermined group, and said management unit is operable to accept the deletion request and add "1" to the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and accept the deletion request and add "1" to the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by



said group judging unit (**pars. 43-52, copy control, domain traversal, 56-59, verifying device belongs to domain, 60-65, copy control, domain traversal, positive integer**).

**Regarding claim 32**, Alve teaches an acquisition unit operable to acquire a start time of a duplication or a deletion of content; and a time management unit operable to output an operation instruction to said management unit at the start time, wherein said management unit, upon receipt of the operation instruction, is operable to manage the number of content duplications performed on the at least one apparatus based on the in-group remaining number when the at least one apparatus is judged: to belong to the predetermined group by said group judging unit, and manage the number of content duplications performed on the at least one apparatus based on the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit (**pars. 43-52, copy control, pars. 60-63, further copy control time related**).

**Regarding claim 33**, Alve teaches an acquisition unit operable to acquire a usage expiration date of the content; and a time management unit operable to output an operation instruction to said management unit when the usage expiration date has passed, wherein said management unit, upon receipt of the operation instruction, is operable to add "1" to the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit; and add "1" to the out-group remaining number when the at least one apparatus is judged not to

belong to the predetermined group by said group judging unit (**pars. 43-52, copy control, pars. 60-63, further copy control time related**).

**Regarding claim 34**, Alve teaches wherein said management unit is operable to notify, to the apparatus, transfer information showing a number that is less than or equal to the in-group remaining number, and a number that is less than or equal to the out-group remaining number, and subtract the numbers shown by the transfer information from the in-group remaining number and the out-group remaining number (**pars. 43-52, copy control, pars. 63-66, voucher based access permissions to content**).

**Regarding claim 35**, Alve teaches an acquisition unit operable to acquire duplication-generation information relating to the content, wherein said management unit is operable to manage the number of content duplications based on the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications based on the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit (**pars. 43-52, copy control, pars. 63-66, voucher based access permissions to content**)..

**Regarding claim 36**, Alve teaches an acquisition unit operable to acquire request-apparatus information unique to the at least one apparatus and a revocation list showing one or more apparatuses to which content duplication is not permitted, wherein said management unit is operable to manage the number of content duplications based on the request-apparatus information, the revocation list, the duplication- generation information and the in-group remaining number when the at least one apparatus is

judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications based on the request-apparatus information, the revocation list, the duplication-generation information and the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by said group judging unit (**pars. 43-52, copy control, pars. 63-66, voucher based access permissions to content, pars. 71-74, transferring copies, access**).

**Regarding claim 37**, Alve teaches an acquisition unit operable to acquire request-area information showing an area relating to the at least one apparatus, wherein said management unit is operable to manage the number of content duplications based on the request-area information and the in-group remaining number when the at least one apparatus is judged to belong to the predetermined group by said group judging unit, and manage the number of content duplications based on the request-area information and the out-group remaining number when the at least one apparatus is judged not to belong to the predetermined group by the group judging unit (**pars. 21-25, domain, household devices, LAN**).

**Regarding claim 38**, Alve teaches an authentication unit operable to share a session key with the at least one apparatus by conducting authentication processing with the at least one apparatus; and an encryption/decryption unit operable, if authentication is successful, to encrypt and decrypt communication with the at least one apparatus using the session key (**pars. 41-44, encrypted communications**).

**Regarding claim 39**, Alve teaches an acquisition unit operable to acquire a duplication request and a deletion request; and a request accumulation unit operable to

manage one of the duplication request and the deletion request using a request-arrival sequence queue, and to have said management unit execute a deletion request that is subsequent in the queue to a duplication request, prior to the duplication request (**pars. 43-52, copy control, domain traversal, 56-59, verifying device belongs to domain, 60-65, copy control, domain traversal, positive integer**).

**Regarding claim 40**, Alve teaches an acquisition unit, wherein the network is a home network connected to an external network, said acquisition unit is operable to acquire the content from outside the home network, and said group judging unit is operable to judge the at least one apparatus connected to the home network as belonging to the predetermined group (**pars. 19-26, home network**).

**Regarding claim 44**, Alve teaches wherein said content management apparatus is operable to request an accounting system to manage accounting (**pars. 52-54, payment**).

### ***Conclusion***

12. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David García Cervetti whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for


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published applications may be obtained from either Private PAIR or Public PAIR.  
Status information for unpublished applications is available through Private PAIR only.  
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
you have questions on access to the Private PAIR system, contact the Electronic  
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USPTO Customer Service Representative or access to the automated information  
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Garcia Cervetti/

NASSER MOAZZAMI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
2/4/08